

## REMARKS

Claims 1-22 and 64-72 were pending in the application. In the Office Action dated August 11, 2004, claims 2-7, and 13-18 are withdrawn from consideration as belonging to a non-elected species, claims 1, 8-10, 12, 19-21, 64, 69 and 70 are rejected, and claims 11, 22, 65-68, 71 and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In the instant Amendment, claims 1, 11, 12, 22, 65, 69, 70, and 72 have been amended, and new claim 73 has been added. Upon entry of the above-made amendment, claims 1-22 and 64-73 will be pending.

Claims 1 and 12 have been amended to recite that  $D_{target}$  and  $D_{off-target}$  are represented by either one of the following: (i)  $D_{target} = R_{target,k}(\alpha_{target})$  and  $D_{off-target} = R_{off-target,k}(\alpha_{off-target})$ , respectively; (ii)  $D_{target} = \sum_k \beta_k R_{target,k}(\alpha_{target})$  and  $D_{off-target} = \sum_k \beta_k R_{off-target,k}(\alpha_{off-target})$ , respectively; or (iii)  $D_{target} = C_{target}$  and  $D_{off-target} = C_{off-target}$ , respectively. Support for the amendment is found in the specification at page 35, line 25, through page 36, line 25.

Claims 11, 22, and 65 have been amended to be in independent form including all of the limitations of the base claim and any intervening claims.

Claims 64 and 70 have been amended to recite that the decomposing comprises representing said drug response profile in terms of said one or a combination of pathway response profiles according to equation  $D_k(t_l) \equiv \sum_i R_{i,k}(\alpha_i, t_l)$ . Support for the amendment is found in the specification in Equation 5, page 26, lines 1-6.

Claim 69 has been amended to depend on claim 65.

Claim 72 has been amended to also depend on claims 1 and 12. Support for the amendment is found in the specification at page 38, lines 1-11.

Claims 11, 22, and 72 have also been amended to correct a typographical error.

New claim 73 has been added. Support for the new claim is found in the specification at, e.g., page 35, line 25, through page 36, line 25.

No new matter has been added by these amendments. Entry of the foregoing amendments and consideration of the following remarks are respectfully requested.

**THE REJECTION UNDER 35 U.S.C. § 103 (a)**  
**SHOULD BE WITHDRAWN**

Claims 1, 8-10, 12, 19-21, 64, 69 and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rine et al., U.S. Patent No. 5,777,888 (“Rine”). The Examiner maintained and reiterated the rejection from the previous office action.

A finding of obviousness under 35 U.S.C. § 103(a) requires a determination that the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. Deere*, 383, U.S. 1 (1956). The relevant inquiry is whether the prior art suggests the invention and whether the prior art provides one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be found in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Rine teaches systems and methods for generating and analyzing stimulated physical matrices, e.g., genome reporter matrices. The stimulated physical matrix of Rine comprises an array of units, each comprising a different responder, e.g., a gene, of a living thing or a probe corresponding to such a responder and an identifier for the responder or probe. The living thing is provided a stimulus, e.g., a drug, capable of repressing the responders of a plurality of the units and the identifiers provide physical signals corresponding to the repression of the respective responders. Rine teaches analyzing such physical matrices by comparing a stimulated physical matrix with a stimulated physical matrix database. Rine also teaches comparing the number of reporters affected by a first drug to the number of reporters affected by a second drug to determine relative specificity of the first drug to that of the second drug.

With respect to independent claims 1 and 12, Applicants respectfully submit that these claims have been amended to recited that  $D_{target}$  and  $D_{off-target}$  are represented by either one of the following: (i)  $D_{target} = R_{target,k}(\alpha_{target})$  and  $D_{off-target} = R_{off-target,k}(\alpha_{off-target})$ , respectively; (ii)  $D_{target} = \sum_k \beta_k R_{target,k}(\alpha_{target})$  and  $D_{off-target} = \sum_k \beta_k R_{off-target,k}(\alpha_{off-target})$ ,

respectively; or (iii)  $D_{target} = C_{target}$  and  $D_{off-target} = C_{off-target}$ , respectively, where  $\alpha_{target}$  is a scaling constant of a scaling transformation of said target pathway,  $\alpha_{off-target}$  is a scaling constant of a scaling transformation of said at least one of its off-target pathway,  $R_{target,k}(\alpha_{target})$  is a scaled response of cellular constituent  $k$  in said target pathway and  $R_{off-target,k}(\alpha_{off-target})$  is a scaled response of cellular constituent  $k$  in said at least one of its off-target pathway,  $\beta_k$  is a constant for cellular constituent  $k$ ,  $C_{target}$  is the minimal level of said drug to achieve a threshold response in said target pathway and  $C_{off-target}$  is the minimal level of said drug to achieve a threshold response in said at least one of its off-target pathways. Although Rine teaches measurement of a plurality of cellular constituents, e.g., as represented by a plurality of units of its physical matrix, Rine does not teach or suggest representing  $D_{target}$  and  $D_{off-target}$  by any one of these quantities. Nor does Rine teach or suggest evaluating the specificity of a drug by comparing  $D_{target}$  and  $D_{off-target}$  as represented by these quantities. A person of ordinary skill in the art would not be motivated with a reasonable expectation of success to represent  $D_{target}$  and  $D_{off-target}$  in the manner as claimed in the amended claims 1 and 12, and to evaluate the specificity of a drug by comparing  $D_{target}$  and  $D_{off-target}$  so represented. Therefore, Applicants respectfully submit that the invention as claimed in the amended claims 1 and 12, and the claims dependent thereon, are nonobvious under 35 U.S.C. § 103 (a) over Rine, and that the rejection of these claims under 35 U.S.C. § 103 (a) over Rine should be withdrawn.

With respect to independent claims 64 and 70, Applicants respectfully submit that these claims have been amended to recited that the decomposing comprises representing the drug response profile in terms of the one or a combination of pathway response profiles according to equation

$$D_k(t_l) \equiv \sum_i R_{i,k}(\alpha_i, t_l)$$

wherein  $t_l$  is a level of the drug,  $\alpha_i$  is a scaling constant of a scaling transformation of pathway  $i$ ,  $D_k(t_l)$  is the measurement of cellular constituent  $k$  in said drug response profile at the drug exposure level of  $t_l$ ,  $R_{i,k}(\alpha_i, t_l)$  is the measurement of cellular constituent  $k$  in pathway  $i$  at the drug exposure level of  $t_l$ . Rine does not teach or suggest decomposing a drug response profile into one or a combination of pathway response profiles as claimed. Nor does Rine teach or suggest evaluating specificity of the drug by comparing, among the one or a

combination of pathway response profiles, the pathway response profiles for the one or more biological pathways associated with therapeutic effects of the drug with the pathway response profiles for the one or more biological pathways that are associated with one or more non-therapeutic effects of the drug. A person of ordinary skill in the art would not be motivated with a reasonable expectation of success to decompose a drug response profile as claimed in the amended claims 64 and 70. Thus, Applicants respectfully submit that the invention as claimed in the amended claims 64 and 70, and the claims dependent thereon, are nonobvious under 35 U.S.C. § 103 (a) over Rine, and that the rejection of these claims under 35 U.S.C. § 103 (a) over Rine should be withdrawn.

**THE OBJECTION TO CLAIMS 11, 22, 65-68, 71 and 72 SHOULD BE WITHDRAWN**

Claims 11, 22, 65-68, 71 and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended these claims to be in independent form including all of the limitations of the base claim and any intervening claims. Therefore, the objection to claim 11, 22, 65-68, 71 and 72 is obviated and should be withdrawn.

**CLAIMS WITHDRAWN FROM CONSIDERATION AS BELONGING TO NON-ELECTED SPECIES SHOULD BE CONSIDERED**

Claims 2-7 and 13-21 were withdrawn from consideration by the Examiner as belonging to non-elected species. Since Applicants believe that the generic claims are allowable, claims 2-7 and 13-21 should be considered by the Examiner. Applicants respectfully request that these claims be considered by the Examiner.

**CONCLUSION**

Applicants respectfully request entry of the foregoing amendments and remarks into the file of the above-identified application. Applicants believe that all the pending claims are

in condition for allowance. Withdrawal of the Examiner's rejections and allowance of the application are respectfully requested.

Respectfully submitted,

Date: November 10, 2004

  
Adriane M. Antler 32,605  
(Reg. No.)  
**JONES DAY**  
222 East 41st Street  
New York, New York 10017-6702  
Phone: (212) 326-3939